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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,368	04/12/2004	Steven A. Bogen	1159.1004-006	4846

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EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,368

Applicant(s)

BOGEN ET AL.

Examiner

Lyle A. Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/14/05; 4/12/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-5 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 11 specify the slide support has plural heated surfaces which does not appear to further limit the respective base claims directed to a heated surface supporting a single slide. It is not clear if structure is intended to heat plural surfaces for a single slide or plural heating surfaced for plural slides. For the purposes of examination, it will be assumed plural surfaces for plural slides was intended.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,783,733.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a slide staining apparatus having means to dispense a liquid on a slide and means to heat the slide.

Claims 8-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 15-21 of U.S. Patent No. 6,541,261 and 6,673,620 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to methods of dispensing a sample on a slide and subsequent heating of the slide.

Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/864,620. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a slide staining apparatus having means to dispense a liquid on a slide and means to heat the slide.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-18 of copending Application No. 09/702,298. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a slide staining method and apparatus having means to dispense a liquid on a slide and means to heat the slide.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2, 4-9 and 11-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rogers et al. (USP 4,043,292).

Rogers et al. teach a microscope slide staining apparatus with temperature control. Figure 7 teach microscope slides(92) advancing across platen(94) that is heated by elements(102). Column 2 lines 64+ teach reactant dispenser(44). The claimed platform for supporting the slides has been read on the taught "platen(94)" and the claimed liquid dispenser on taught "dispenser(44)". In light of the 35 USC 112 second paragraph issues above, claims 4-5 and 11-12 it will be assumed plural surfaces for plural slides was intended which has been taught by Rogers et al.

Claims 1-14 are rejected under 35 U.S.C. 102(b,e) as being clearly anticipated by Bogen (USP 4,847,208 and 5,073,504 respectively).

These references teach incubation chamber(4)[see column 6 lines 43+ and column 7 lines 56-64] that contain slides. Valves are taught to supply and remove the samples. The claimed platform for supporting the slides has been read on the taught "incubation chamber(4)" and the claimed liquid dispenser on taught "valves". Bogen further teaches a plurality of the incubation chambers(4) which meet the claimed limitations of a "heated surface area supports only one slide" and the plural chambers the limitations of "plural heated surfaces".

Claims 1-2,4-9 and 11-14 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Copland et al. (USP 5,654,200).

Copeland et al. teach a method and apparatus for the processing of microscope slides by application of a reagent and heating. Figures 12-13 teach application of a heated rinse solution to the slides which has been read on the claimed "heater thereunder, the heated surface area being in contact with and underlying a microscope slide. In light of the 35 USC 112 second paragraph issues above, claims 4-5 and 11-12 it will be assumed plural surfaces for plural slides was intended which has been taught by Copeland et al.

Claims 1-2,4-9 and 11-14 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Heidt et al (USP 5,089,229).

Heidt et al. teach a slide analyzer. Figure 8a teach turntable(50) to hold slides(71). Heater plate(380) is beneath the turntable(50) and provides heating.

Pipette(18) supplies the sample to each slide. In light of the 35 USC 112 second paragraph issues above, claims 4-5 and 11-12 it will be assumed plural surfaces for plural slides was intended which has been taught by Heidt et al.

Claims 1-2,4-9 and 11-14 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kerr et al. (USP 5,075,079).

Kerr et al. teach a slide analysis system. Incubator(14) supports slide modules(24) and is heated by heater(188). Depositing module(16) adds the sample and reagents. The claimed platform for supporting the slides has been read on the taught "incubator(14)" and the claimed liquid dispenser on taught "depositing module(16)". In light of the 35 USC 112 second paragraph issues above, claims 4-5 and 11-12 it will be assumed plural surfaces for plural slides was intended which has been taught by Kerr et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidt et al (USP 5,089,229), Copland et al. (USP 5,654,200), Kerr et al. (USP 5,075,079) or Rogers et al. (USP 4,043,292).

See the teachings of these references supra.

These references teach a plurality of slides heated by a plural heating means and are silent to the claimed heating surface supporting a single slide.

The court has decided *St. Regis Paper Co. v. Bemis Co., Inc.*, (193 USPQ 8,11) that it is within the skill of the art to duplicate parts to achieve a multiplied effect. Conversely, it would have been within the skill of the art to minimize parts, such as a single element, to achieve the well known and expected result of a minimized effect. It is desirable to have a device capable of processing a single sample so that a sample with a higher priority can be individually processed. It would have been within the skill

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of the art to modify Heidt et al (USP 5,089,229), Copland et al. (USP 5,654,200) or Rogers et al. (USP 4,043,292) and provide a single slide holder to gain the above advantages and in view of the above court decision.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lyle A Alexander
Primary Examiner
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